

### **Initial Comments**

A portion of the history of this Application is as follows:

1. 05/27/98 Application filed, with priority claimed to provisional application 60/031,956 dated 11/27/96.
2. 02/17/00 1st non-final rejection.
3. 04/24/01 Restriction.
4. 06/19/01 2nd non-final rejection.
5. 09/18/01 1st Appeal Brief.
6. 01/31/02 3rd non-final rejection.
7. 03/11/02 2nd Appeal Brief.
8. 10/01/02 1st Suspension.
9. 06/17/03 4th non-final rejection.
10. 07/15/03 5th non-final rejection.
11. 09/19/03 3rd Appeal Brief.
12. 11/29/05 BPAI decision - Examiner completely reversed.
13. 02/08/06 2nd Suspension.
14. 04/25/07 Request for information under 37 CFR § 1.105.

As evidenced by the extraordinary amount of prosecution carried out by the Office, it appears that the Office had long ago internally decided that this application was never to mature into a patent. Thus, as the Office's illegal withholding of application allowance is expected to continue, the Office will predictably not be satisfied no matter how Applicants respond to the current Request for information.

### **Comments on the Request for Information**

The Action includes a Request for Information pursuant to 37 CFR § 1.105 ("Request").

#### **The Request is not legally valid**

The record shows that this application received a Board of Patent Appeals & Interferences' (BPAI) decision on November 29, 2005, which completely reversed the rejections. The suspension carried out starting February 8, 2006 was legally improper not only because it lasted 8 extra months beyond the maximum time limit, but because it also lacked the required approving signature of a Technology Center Director for suspension. This lack of required signature was pointed out in Applicants' letter of March 21, 2006, which the Office conveniently ignored. Now the Office mails the Request, even though prosecution is still legally closed.

The Office continues to ignore that because of the BPAI decision, any attempt to reopen prosecution requires that the written approval of a Technology Center Director be placed on the Office action reopening prosecution. Note MPEP § 1214.04, 1214.07, 1002.02(c)(1), and 37 CFR 1.198. As evidence by the record, the attempted suspension dated February 8, 2006 was absent the required Technology Center Director approval. Likewise, the current Request for information is also absent the required Technology Center Director approval. Until prosecution in this application is first reopened legally, a Request for information cannot be properly made. Thus, prosecution legally remains closed and the Request for information is not legally valid. Applicants have no obligation to respond to a legally invalid Office action (like the Request).

The record points to the Examiner acting without the Technology Center Director's approval. Nor is it reasonable that an experienced Director would agree to reopen prosecution, especially in light of the already extraordinary long prosecution history and the BPAI decision.

The Request is improper because prosecution is closed

As previously discussed, prosecution remains closed. MPEP § 704.11(b) makes clear that "a request for information should *not* be made with or after" prosecution is closed. MPEP § 704.11(b)(III) makes clear that if a Request for information is not in a non-final Office action (which is the current situation), then such Request for information is legally improper. It follows that the Request is improper and should be withdrawn.

The Request is improper because it is not timely

MPEP § 704.11(b)(III) makes clear that it is rare "to require information because of a lack of relevant prior art after the first action on the merits". The "first action on the merits" in the present application occurred on February 17, 2000, which was more than 7 years ago. In spite of the record lacking one iota of evidence necessitating such a rare need for information after a first action, especially a first action 7 years prior, this is somehow the current situation. To say that the Request for information is not timely is a severe understatement.

The Request is improper because it is unclear

The scope of the Request is not narrowly defined, as is required in accordance with MPEP § 704.11. What constitutes the information requested is unclear, especially in light of the claimed invention being novel and nonobvious. For example, as best understood, the Request in paragraph number 2 is stating "how" the information will be used by the Examiner, not "what" information is being requested. The statement (in paragraph number 2) that "The information is required [in order for the Examiner to later be able] to identify all related applications" and "properties of similar products . . . in the prior art" is clearly a "how the information will be used" statement. Thus, as best understood, paragraph number 2 is not a request for information.

Additionally, the Request is vague and indefinite. One skilled in the art of patent prosecution would not understand what specific information (if any) is being requested by the Office. The Request is also unclear because it (in paragraph numbers 2 and 3) does not define what constitutes "related applications", "similar products", "related case", "applied or otherwise", and "relates". It is unclear whether these terms and phrases are intended to cover all prior art patents/applications filed (by anyone) in the USPTO which have been classified in the same class/subclass as the instant application. Applicants respectfully submit that the Office already has this lengthy information. A Request for information cannot require an Applicant to submit information that the Office already possesses. Again, the Request is legally improper.

Furthermore, the Request is not limited to "facts" as is required, but instead appears to improperly expect "opinions" to be formulated by Applicants. For example, the Request (in paragraph number 3) refers to "an explanation of how the prior art relates to the claimed subject matter". Thus, the Request is in direct violation of MPEP § 704.11 which makes clear that any Request for information which requests "opinions that may be held or would be required to be formulated by applicant" is not a legally valid Request for information. In the same context, "opinions" would also need to be formulated by Applicants with regard to the previously discussed "related applications", "similar products", "related case", "applied or otherwise", and "relates". Again, the Request is improper and should be withdrawn.

The Request is improper because the information requested is not reasonably necessary

Applicants respectfully submit that the Request is improper because the information requested is not reasonably necessary to properly examine or treat a matter in the current application.

MPEP § 704.11 makes clear that "a requirement under 37 CFR 1.105 may *only* be made when the examiner has a reasonable basis for requiring information". The criteria "for making a requirement for information is that the information be reasonably necessary to the examination or treatment of a matter in an application". The legal criteria of reasonable necessity is met where:

- (A) The claimed subject matter cannot be adequately searched. This instance occurs where the invention as a whole is in a new area of technology which lacks any patent classification; or
- (B) The application file justifies asking for information. This instance occurs where the application file itself suggests an applicant has access to information necessary for a more complete understanding of the invention.

The present application has already been searched based upon USPTO classification. Nor is the application in a new area of technology. Thus, the Office has not met criteria (A).

The Office has not cited any part of the application file that points to the Applicants having additional information. Nor has the Office shown that the invention is so complex that a more complete understanding thereof would be needed by a competent examiner. Thus, the Office has not met criteria (B).

The Request is improper because there is no reasonable basis for requesting information. As shown by Applicants, the Office has not met either criteria (A) or criteria (B). It follows that the Office has not met the legal criteria for imposing the Request. At best, the Request appears to be another futile fishing expedition (like the suspensions and the reversed rejections) by the Office to improperly deny the grant of patent. Again, the Request is improper and should be withdrawn.

### USPTO PAIR system information

As evidenced by the USPTO's own PAIR system, the instant application was the National Stage of International application PCT/US97/21422 (filed 11/25/1997), which claimed the benefit of U.S. provisional application 60/031,956 (filed 11/27/1996). As a courtesy to the Office, attached are printouts (comprising 3 total sheets) from the Office's own PAIR system showing continuity application data for each of the instant application, the PCT application, and the provisional application. Of course this information is not new to the Office, which produced and furnished the information. Not only does the Office already have this information, but it also has easy access to all data embodying each listed application.

### Applicants' Comments constitute a complete reply to the Request

As previously discussed, it is unclear what "information" the Request seeks. At present the "information" requested to be submitted is inherently unknown and/or not readily available to the party or parties from which it was requested.

It is respectfully submitted that no other comments by Applicants are deemed necessary with regard to the Request, as it is best understood. In accordance with MPEP § 704.12(b), a statement that the information requested to be submitted is unknown and/or not readily available to the party or parties from which it was requested constitutes a complete reply to a 37 CFR 1.105 request. Therefore, Applicants response herein constitutes a complete reply to the Request.

### Conclusion

Applicants respectfully submit that this application is in condition for allowance. The undersigned is willing to discuss any aspect of the application at the Office's convenience.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Locke', written over a horizontal line.

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09/077,337      AUTOMATED BANKING MACHINE APPARATUS AND SYSTEM      06-19-2007::11:00:48

### Parent Continuity Data

Description	Parent Number	Parent Filing or 371(c) Date	Parent Status	Patent Number
This application is National Stage Entry of	PCT/US97/21422	11-25-1997	Pending	-

### Child Continuity Data

09/193,647 filed on 11-17-1998 which is Patented claims the benefit of 09/077,337  
 09/193,791 filed on 11-17-1998 which is Patented claims the benefit of 09/077,337  
 10/223,693 filed on 08-19-2002 which is Patented claims the benefit of 09/077,337  
 10/305,083 filed on 11-25-2002 which is Patented claims the benefit of 09/077,337  
 10/390,586 filed on 03-17-2003 which is Pending claims the benefit of 09/077,337  
 11/003,791 filed on 12-03-2004 which is Pending claims the benefit of 09/077,337  
 11/003,821 filed on 12-03-2004 which is Pending claims the benefit of 09/077,337  
 11/048,345 filed on 01-31-2005 which is Pending claims the benefit of 09/077,337  
 11/099,369 filed on 04-04-2005 which is Pending claims the benefit of 09/077,337  
 11/125,518 filed on 05-09-2005 which is Pending claims the benefit of 09/077,337  
 11/179,457 filed on 07-11-2005 which is Pending claims the benefit of 09/077,337  
 11/203,488 filed on 08-12-2005 which is Pending claims the benefit of 09/077,337  
 11/226,104 filed on 09-14-2005 which is Pending claims the benefit of 09/077,337  
 11/226,540 filed on 09-14-2005 which is Pending claims the benefit of 09/077,337  
 11/270,392 filed on 11-08-2005 which is Pending claims the benefit of 09/077,337  
 11/356,818 filed on 02-17-2006 which is Pending claims the benefit of 09/077,337  
 11/601,556 filed on 11-17-2006 which is Pending claims the benefit of 09/077,337  
 11/732,861 filed on 04-05-2007 which is Pending claims the benefit of 09/077,337

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**PCT/US97/21422 AUTOMATED BANKING MACHINE APPARATUS AND SYSTEM****06-19-2007::11:02:49****Parent Continuity Data**

<b>Description</b>	<b>Parent Number</b>	<b>Parent Filing or 371(c) Date</b>	<b>Parent Status</b>	<b>Patent Number</b>
This application Claims Priority from Provisional Application	60/031,956	11-27-1996	Pending	-

**Child Continuity Data**

09/193,647 filed on 11-17-1998 which is Patented claims the benefit of PCT/US97/21422  
09/193,791 filed on 11-17-1998 which is Patented claims the benefit of PCT/US97/21422  
09/578,291 filed on 05-25-2000 which is Pending claims the benefit of PCT/US97/21422  
09/638,848 filed on 08-14-2000 which is Patented claims the benefit of PCT/US97/21422  
10/126,140 filed on 04-19-2002 which is Patented claims the benefit of PCT/US97/21422  
10/223,693 filed on 08-19-2002 which is Patented claims the benefit of PCT/US97/21422  
10/226,193 filed on 08-21-2002 which is Patented claims the benefit of PCT/US97/21422  
10/305,083 filed on 11-25-2002 which is Patented claims the benefit of PCT/US97/21422  
10/356,849 filed on 02-03-2003 which is Pending claims the benefit of PCT/US97/21422  
10/357,145 filed on 02-03-2003 which is Pending claims the benefit of PCT/US97/21422  
10/390,586 filed on 03-17-2003 which is Pending claims the benefit of PCT/US97/21422  
10/430,123 filed on 05-05-2003 which is Pending claims the benefit of PCT/US97/21422  
10/738,756 filed on 12-17-2003 which is Patented claims the benefit of PCT/US97/21422  
10/754,367 filed on 01-09-2004 which is Pending claims the benefit of PCT/US97/21422  
10/936,242 filed on 09-07-2004 which is Pending claims the benefit of PCT/US97/21422  
10/957,287 filed on 09-30-2004 which is Pending claims the benefit of PCT/US97/21422  
10/980,209 filed on 11-02-2004 which is Pending claims the benefit of PCT/US97/21422  
10/980,345 filed on 11-02-2004 which is Patented claims the benefit of PCT/US97/21422  
10/990,334 filed on 11-16-2004 which is Pending claims the benefit of PCT/US97/21422  
11/003,791 filed on 12-03-2004 which is Pending claims the benefit of PCT/US97/21422  
11/003,821 filed on 12-03-2004 which is Pending claims the benefit of PCT/US97/21422  
11/033,601 filed on 01-12-2005 which is Pending claims the benefit of PCT/US97/21422  
11/048,345 filed on 01-31-2005 which is Pending claims the benefit of PCT/US97/21422  
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11/123,654 filed on 05-06-2005 which is Pending claims the benefit of PCT/US97/21422  
11/125,518 filed on 05-09-2005 which is Pending claims the benefit of PCT/US97/21422  
11/135,948 filed on 05-23-2005 which is Pending claims the benefit of PCT/US97/21422  
11/179,457 filed on 07-11-2005 which is Pending claims the benefit of PCT/US97/21422  
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11/226,540 filed on 09-14-2005 which is Pending claims the benefit of PCT/US97/21422  
11/270,392 filed on 11-08-2005 which is Pending claims the benefit of PCT/US97/21422  
11/356,818 filed on 02-17-2006 which is Pending claims the benefit of PCT/US97/21422  
11/601,556 filed on 11-17-2006 which is Pending claims the benefit of PCT/US97/21422  
11/732,861 filed on 04-05-2007 which is Pending claims the benefit of PCT/US97/21422

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**Parent Continuity Data**

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Description	Parent Number	Parent Filing or 371(c) Date	Parent Status	Patent Number
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No Parent Continuity Data Found.

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**Child Continuity Data**

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09/193,564	filed on 11-17-1998	which is Pending	claims the benefit of 60/031,956
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09/193,623	filed on 11-17-1998	which is Patented	claims the benefit of 60/031,956
09/193,624	filed on 11-17-1998	which is Patented	claims the benefit of 60/031,956
09/193,627	filed on 11-17-1998	which is Patented	claims the benefit of 60/031,956
09/193,634	filed on 11-17-1998	which is Patented	claims the benefit of 60/031,956
09/193,635	filed on 11-17-1998	which is Patented	claims the benefit of 60/031,956
09/193,637	filed on 11-17-1998	which is Patented	claims the benefit of 60/031,956
09/193,638	filed on 11-17-1998	which is Patented	claims the benefit of 60/031,956
09/193,646	filed on 11-17-1998	which is Patented	claims the benefit of 60/031,956
09/193,647	filed on 11-17-1998	which is Patented	claims the benefit of 60/031,956
09/193,662	filed on 11-17-1998	which is Patented	claims the benefit of 60/031,956
09/193,787	filed on 11-17-1998	which is Pending	claims the benefit of 60/031,956
09/193,791	filed on 11-17-1998	which is Patented	claims the benefit of 60/031,956
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09/639,310	filed on 08-14-2000	which is Pending	claims the benefit of 60/031,956
09/863,911	filed on 05-23-2001	which is Pending	claims the benefit of 60/031,956
09/949,283	filed on 09-07-2001	which is Patented	claims the benefit of 60/031,956
09/972,400	filed on 10-05-2001	which is Pending	claims the benefit of 60/031,956
10/126,140	filed on 04-19-2002	which is Patented	claims the benefit of 60/031,956
10/223,693	filed on 08-19-2002	which is Patented	claims the benefit of 60/031,956
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11/356,818	filed on 02-17-2006	which is Pending	claims the benefit of 60/031,956
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PCT/US97/21422	filed on 11-25-1997	which is Pending	claims the benefit of 60/031,956

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